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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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EXAMINER

LONEY, DONALD J

ART UNIT

PAPER NUMBER

1772

DATE MAILED: 01/28/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|----------------------|------------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 08/717553 | Malpass et al |
| | Examiner O. Loney | Group Art Unit 1772 |

AS 9
—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication .
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

Responsive to communication(s) filed on 10/31/02.

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

Claim(s) 1, 2, 4-13, 16-20 is/are pending in the application.

Of the above claim(s) _____ is/are withdrawn from consideration.

Claim(s) _____ is/are allowed.

Claim(s) 1, 2, 4-13, 16, 17, 18, and 20 is/are rejected.

Claim(s) 19 is/are objected to.

Claim(s) _____ are subject to restriction or election requirement.

Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The proposed drawing correction, filed on _____ is approved disapproved.

The drawing(s) filed on _____ is/are objected to by the Examiner.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All Some* None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) _____.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

Attachment(s)

Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

Interview Summary, PTO-413

Notice of Reference(s) Cited, PTO-892

Notice of Informal Patent Application, PTO-152

Notice of Draftsperson's Patent Drawing Review, PTO-948

Other _____

Office Action Summary

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 5, a third layer is recited, however, a second layer has not been established.

Therefore, this is confusing in nature.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

4. (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
5. Claims 1, 4, 6, 7, 16, 17 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Heine.

Heine teaches a product with two layers (11 and 12) that has cylindrical recessions (13) in the bottom. Refer to Fig. No. 3. The product by process claims are included within this rejection, and will be in all others including claim 1, since it is the patentability of the product that is in issue, not the patentability of the process steps employed to prepare the product. See *In re Fessmann*, 180 USPQ 324 and *In re Brown*, 173 USPQ 685. Claim 20 is included since the first and second diameters are at recited as different.

6. Claims 1, 2, 4, 16 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Corson.

Corson teaches a rubber mat with recessions that are round which form cylindrical recessions. Refer to Fig. Nos. 8 and 9 along with column 2, lines 43-47.

7. Claims 1, 2, 4, 6, 8, 13, 16, 17, 18 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Shiner.

Shiner teaches a multiplayer rubber mat wherein the bottom layer (either layer 7) has cylindrical recessions since they take the form of the two different sized (3 and 5). Refer to Fig. Nos. 1 and 2 along with the corresponding text. The mat may also contain antibacterial materials. Refer to page 2, column 1, lines 6-8.

8. Claims 1, 2, 5, 6, 8, 16 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Tesch.

Tesch teaches a mat with a fabric layer (2) and a backing layer (7) that has cylindrical recessions therein. Refer to Fig. Nos. 2 along with column 9, lines 14-16.

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over shiner or Tesch.

The primary references fail to teach the variety of rubbers and two different hardnesses.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use a mixture of rubbers, since in recycling a variety of rubbers are usually mixed to form new products, for the composite layers. It would also be obvious to form the lower layer of

a softer material in order to provide a better cushioning effect. The top layer usually needs to be tougher since it is subject to repeated direct contact.

11. Claim 19 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

12. Applicant's arguments with respect to claims 1, 2, 4-13 and 16-20 are have been considered but are moot in view of the new ground(s) of rejection.

13. Any inquiry concerning this communication should be directed to D. Loney at telephone number 703-308-2416.

D. Loney/mn
January 21, 2003


DONALD J. LONEY
PRIMARY EXAMINER